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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,768	11/17/2005	Eric Zimmerman	047P 1861	7260
23460 7590 09/16/2009 LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6731				
EXAMINER KELLY, CATHERINE A				
ART UNIT 3634		PAPER NUMBER		
NOTIFICATION DATE 09/16/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Chgpatent@leydig.com
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Office Action Summary

Application No.

10/519,768

Applicant(s)

ZIMMERMAN ET AL.

Examiner

CATHERINE A. KELLY

Art Unit

3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/309)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/2/2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 line 4 includes the limitation "and/or" which is indefinite as it is unclear whether the rail, module, or both have a receiver. Further, applicant is requested to show examiner where support for all 3 embodiments is in the specification—specifically, support for at least one receiver in both the rail and the module. Further, if the rail has a receiver, how does it receive itself as the claim requires "a receiver for the positive fit retention of the window-lifting rail?" Claim 1 line 4 also includes the limitation "for the positive-fit," however, the term positive-fit is indefinite. There is no dictionary definition and no clear definition in the specification. While the specification does mention a "pocket-like" receiver, pocket-like itself is also an indefinite term and thus does not shed any light on the situation. Claim 1 line 6 includes

the limitation "a step-like support," however the term step-like is indefinite-- the phrase "-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "-- like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim 3 line 2 includes the limitation "and/or" which is indefinite as it is unclear whether the rail, module, or both have a pin.

Claim 9 is generally unclear. The lack of punctuation or transition after "frame" in line 2 makes it difficult to discern what paneling modifies. Should it be "comprises a frame, and a paneling" or "comprises a frame with a paneling?" Does "its side" refer to the side of the door or the frame? Are there two panels, one at the distant side and one at the interior facing side or is there one panel? Of necessity, claim will be read very broadly as requiring a door with a frame and a panel.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PG Pub 2004/0211122. The elements of the door of claim 1 are shown in figures 1, 2a and b, and 4 of the '122 reference where a windowpane movable therein not shown but taught in paragraph [0027]; at least one window-lifting rail 4 for guiding the windowpane; and a module support 3 attached in the interior of the motor vehicle door for accommodation of elements, wherein the module support 3 comprises at least one receiver 30 for the positive-fit retention of the window-lifting rail 4 in the module support 3, and additionally wherein the module support 3 comprises at least one receiver 14 having a projection (as clearly shown in figure 1 receiver 14 protrudes or projects in the direction of rail 4) supporting a step-like support of the window lifting rail 4 as taught in paragraph [0028] for accommodating the vertical weight forces of the window lifting rail with a bore running in the vehicle vertical axis (unnumbered but clearly shown as receiving fixing means 400b), a fixing means 400b running through the bore, for fixation of the window lifting rail, to ensure that this fixing means 400b does not need to accommodate weight forces of the window lifting rail 4 as taught in paragraph [0028].

While the fixing means of the '122 reference is not a "screwing" as stated in claim 1, Examiner takes Official Notice that screwing means were well known means of fastening in the art at the time.

Further, while the fixing means of the '122 reference does not run in the direction of the vehicle vertical axis, as the rail 4 goes onto the receiver 14 as taught in paragraph [0028] it would be possible to place a fixing means in a vertical direction and to do so would be mere rearrangement of parts and thus obvious, see MPEP 2144.40 VI Section C.

One of ordinary skill would be motivated to provide the door of the '122 reference with a screwing means because the replacement of the fastening means shown in the '122 reference with a screw would have been an obvious substitution of one known element for another with predictable results.

Regarding claim 2, an additional screwing would be mere duplication of parts and thus obvious, see MPEP 2144.04 VI Section B. One of ordinary skill would be motivated to duplicate because an additional fastener would provide a more secure fastening.

Regarding claim 5, the '122 reference shows two rails in figure 4 reference numeral 4.

Regarding claim 6, the '122 reference teaches a rail made of plastic in claim 4. However, Examiner takes Official Notice that window lifting rails of metal were well known in the art at the time. It would have been obvious to one of ordinary skill in the art at the time of invention. One of ordinary skill would be motivated to combine because the substitution of a metal rail for a plastic one would be a substitution of one known element for another with predictable results.

Regarding claim 7, the plastic module is taught in the '122 reference in paragraph [0027].

Regarding claim 8, the door structure is shown in the '122 reference in figures 1 and 4 where the inner panel is reference numeral 1 with module 3 attached at base structure profile 13 and outer skin 2.

Regarding claim 9, the door frame is shown in the '122 reference in figures 1 and 4 where the door frame 6 has attached inner panel 1 and outer panel 2.

Regarding claim 10, the module accommodating loud speakers is shown in figure 4 where the unnumbered round region in module 3 is clearly for a loud speaker.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0211122 as applied to claim 1 above, and further in view of US PG Pub 2004/0049988. The '122 reference shows the alignment of the window lifting rail on the module in figures 2a and b where the rail is reference numeral 4 and the module 3. However, the '122 reference shows the alignment via bearing and an axel, not the pin of claim 3. The pin structure is shown in the '988 reference in figure 2b reference numeral 56. It would have been obvious to one of ordinary skill in the art at the time of invention. One of ordinary skill would be motivated to combine because the replacement of the positioning axel with a pin would be substitution of one known element for another with predictable results.

Regarding claim 4, two pins instead of one would be mere duplication of parts and thus obvious, see MPEP 2144.04 VI Section B. One of ordinary skill would be

motivated to use two pins instead of one as two pins may provide a more definite alignment.

Response to Arguments

Applicant's arguments filed 7/2/2009 have been fully considered but they are not persuasive. Applicant states that claim 9 has been modified to overcome the objection of the previous action to include a "first paneling" and a "second paneling," however, the claims Examiner has received do not actually include these limitations and, as stated in the 112 rejection above, do not clarify the limitations of claim 9.

In response to applicant's arguments directed towards the modified claim 1, Examiner maintains that the '122 reference still reads over the limitations of claim 1. Receiver 30 of the '122 reference receives rail 4 and additionally second receiver 40 has the rail 4 placed onto it as taught in paragraph [0028]. Examiner maintains that while this may not look like applicant's drawings, it does cover the claimed limitations as set forth in claim 1, especially in view of the 112 rejection of claim 1 as set forth above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHERINE A. KELLY whose telephone number is (571)270-3660. The examiner can normally be reached on Monday through Friday 9am - 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on 571-272-7069. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. A. K./
Examiner, Art Unit 3634

/KATHERINE W MITCHELL/
Supervisory Patent Examiner, Art
Unit 3634

cak